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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTOPHER E. AXE and MARCO S. CASALAINA

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Appeal 2007-3562  
Application 09/636,418<sup>1</sup>  
Technology Center 2100

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Decided: April 15, 2008

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Before JAY P. LUCAS, ST. JOHN COURTENAY III, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

**STATEMENT OF CASE**

Appellants appeal from a final rejection of claims 1 to 35 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> Application filed August 10, 2000. The real party in interest is Oracle International Corp.

Appellants' invention relates to a system and method for assisting a user to configure a product (e.g. a new car, a computer, a garden) by inputting specifications for the product, especially over the Internet. In the words of the Appellants:

In a system in accordance with the present invention, the inference engine itself may be on a remote server. The client side device may include a visual user interface as well as a small amount of user side intelligence. In one embodiment, the user interface comprises various components that can be selected by the user (called "donors"), and various slots in which they can be placed (called "receptors"). The user can place donors in receptors in a manner corresponding to the physical placement in which the user wants to place the selected components. In this way, in one embodiment, such a visual interface helps the user create a product comprised of selectable components, where each component is placed where the user wants it. An example of such an embodiment is an aircraft control panel.

(Specification 5:7-15).

Claim 1 is exemplary:

1. A method for visually configuring a product by placing a plurality of selectable components into a plurality of slots, comprising:
  - (a) initializing a configuration layout with proper state;
  - (b) receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which the selected object may be placed;
  - (c) providing visual feedback indicating a validity of the selections;

(d) receiving a placement of the selected object;  
(e) receiving input regarding the placement from a remote inference engine;

(f) updating the visual feedback as needed based on the received input; and

(g) repeating steps (b) through (f) until no more selections are received.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

King et al.	US 6,161,114	Dec. 12, 2000
Henson	US 6,167,383	Dec. 26, 2000

Rejections:

In view of the Examiner's withdrawal of rejections of claim 34 under 35 U.S.C. § 101 and under 35 U.S.C. § 112 (Answer, page 3), the remaining rejections under appeal are:

R1: Claims 1 to 3, 6 to 9, 14 to 17, 23 to 30, and 32 to 34 stand rejected under 35 U.S.C. § 102(b) for being anticipated by Henson.

R2: Claims 4, 5, 11 to 13 and 18 to 20 stand rejected under 35 U.S.C. § 103(a) for being obvious over Henson.

R3: Claims 10, 21, 22, 31 and 35 stand rejected under 35 U.S.C. § 103(a) for being obvious over Henson in view of King.

Appellants contend that the claimed subject matter is not anticipated by Henson, or rendered obvious by Henson alone, or in combination with King, for failure of the references to teach claimed subject matter. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).<sup>2</sup>

We affirm-in-part.

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(b) and 103(a). The issue turns on whether Henson teaches each of the claimed steps and elements.

### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

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<sup>2</sup> Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

### ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. §§ 102 and 103. The prima facie case is presented on pages 5 to 15 of the Examiner's Answer.

In opposition, Appellants present a number of arguments. As one of the arguments is dispositive of the appeal with respect to almost all of the claims, that argument will be addressed first.

Appellants contend that the "cited art does not teach '*(b) receiving a selection of one of the plurality of selectable objects, and one of the plurality of slots in which the selected object may be placed.*'" (Brief, page 11, para. b.).

Henson teaches an Internet web page in which a user can configure a computer that he intends to purchase. It contains a number of categories of choices for various components that will comprise the computer (Fig. 3A, col. 6, ll. 18-45), for example, the Memory, the Hard Drive or the Monitor. The Examiner has read the claimed selectable objects on the various choices of components that the user may elect (as from the dropdown menus depicted in the Figure 3, or as displayed in Figure 5). The Examiner has also read the plurality of slots on the various categories of customization depicted

at #77 in the Figure. Appellants concede that the teachings of Henson indicate a plurality of objects for each slot, but point out that Henson does not teach “*a plurality of slots in which the selected object may be placed.*” (Brief, page 11, para. b.) Reviewing Henson in detail, we are convinced that Appellants have indeed found error with this rejection. Each of the selectable objects in Henson can only be placed in a single slot, if placed at all. There is no “plurality of slots in which the selected object may be placed” as claimed.

The error of this rejection extends to affected claims 1 to 3, 6 to 9, 14 to 17, 23, 29, 30, and 32 to 34 of R1, and as the same reference is used in rejecting the dependent claims 4, 5, 11, and 18 to 20 of R2, to those claims as well. The King reference does not cure this deficiency in the primary reference, so the claims 10, 21, 22, 31 and 35, rejected under R3, are also subject to this error.

However, independent claims 12 and 24 do not contain that limitation quoted just above. In claim 12, the plurality of selectable components and plurality of slots are expressed in a collective manner, and validity is expressed in relation to one component in one slot. In claim 24 a single object is described with respect to a single slot. We do not find error with the rejection of these claims, nor the claims dependent on them.

### **CONCLUSION OF LAW**

Based on the above, we conclude that the Examiner erred in rejecting claims 1 to 11, 14 to 23, and 29 to 35. The rejection of the other claims 12, 13, and 24 to 28 is not subject to that error.

**DECISION**

The Examiner's rejection of claims 1 to 11, 14 to 23, and 29 to 35 is reversed. The rejection of claims 12, 13, and 24 to 28 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED-IN-PART**

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